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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/666,817
Filing Date: September 17, 2003
Appellant(s): BUIST, WALTER D.

John C. Stellabotte, Reg. No. 47,969
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 24 September 2007 appealing from the Office action mailed 19 May 2006.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Hausman, US 2004/0030632 A1, February 12, 2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1-24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hausman (U.S. PG Pub No. 2004/0030632).

As per claims 1, 7, 22 and 23, Hausman teaches a method for securely communicating *(transmitting)* financial information *(financial interest)*, comprising receiving over an electronic computer network *(network, 100)* a message communicated according to a field delimited communication protocol *(FIX)* pursuant to which the message comprises a financial data field *(financial interest)* and a field value *(price parameter)* corresponding to the financial data field and the message has a standard, publicly-known meaning within the field delimited communication protocol and interpreting the message according to a coded meaning defined to be different than the standard publicly-known meaning within the filed delimited communication protocol *(see figs 1, 4 and 5, paragraphs 0005-0012, 0032, 0040, 0058)*. Hausman further teaches transmitting the encoded message over an electronic computer network *(see figs 1, 4)*.

As per claims 2, 8, Hausman teaches a method wherein the field delimited communication protocol is the Financial Information Exchange (FIX) Protocol, or a protocol derived therefrom *(see paragraphs 0041)*.

As per claims 3, 9,Hausman teaches a method wherein the message communicates a number of shares ordered or offered (*see fig 4, 5)*.

As per claims 4, 10, Hausman teaches a method wherein the specified financial data field is a FIX tag 38 entry (*see figs 4, 5)*.

As per claims 5, 11, Hausman teaches a method wherein the coded meaning communicates a number of shares of a financial transaction to which the message pertains that is different than the standard, publicly-known meaning within the field delimited communication protocol (*see figs 4, 5, paragraphs 0054)*.

As per claims 6, 12, Hausman teaches a method wherein the wooded message corresponds to an Indication of Interest (I0I) for a number of shares (*see figs 4, 5, paragraphs 0060, 0067)*.

As per claims 13 and 24, Hausman teaches a method for securely communicating financial information, comprising receiving over a first electronic computer network a first message, the first message in a field delimited communication protocol pursuant to which the first message comprises a first financial data field and a first field value corresponding to the first financial data field, in which the message has a standard publicly-known meaning within the field delimited communication protocol, transmitting over a second electronic computer network, a second message, the second message in the field delimited

communication protocol comprising a second financial data field and a second field value corresponding to the second financial data field, in which the second message has a standard publicly-known meaning within the field delimited communication protocol; and at least one of the first and second messages being encoded, wherein each encoded message is intended to have a meaning different from a the standard, public within the field delimited communication protocol wherein, the first and second electronic network, and the first and second messages are not necessarily distinct (*see figs 1, 4 and 5, paragraphs 0005-0012, 0032, 0040, 0058)*.

As per claims 14, Hausman teaches a method wherein the field delimited communication protocol is the Financial Information Exchange (FIX) Protocol, or a protocol derived therefrom (*see paragraphs 0041)*.

As per claims 15,Hausman teaches a method wherein the message communicates a number of shares ordered or offered (*see figs 4, 5, paragraphs 0060, 0067)*.

As per claims 16, Hausman teaches a method wherein the coded meaning communicates a number of shares of a financial transaction to which the message pertains (*see figs 4, 5, paragraphs 0060, 0067)*.

As per claims 17, Hausman teaches a method wherein the wooded message corresponds to an Indication of Interest (IOI) for a number of shares (*see figs 1, 4)*.

As per claims 18, Hausman teaches a method further comprising determining whether corresponding entries first field value and the second field value and match, and if the match is successful, transmitting a notification to one or more broker/dealers (*see figs 4, 5, paragraphs 0054)*.

As per claims 19, Hausman teaches a method wherein the transmitted notification is not encoded (*see figs 1, 4 and 5, paragraphs 0005-0012, 0032, 0040, 0058)*.

As per claims 20, Hausman teaches a method wherein the first message is encoded, and wherein the transmitted notification is made to a plurality of receivers, further comprising, receiving from a receiver a reply to the second message; and determining whether the first field value and the second field value match (*see figs 1, 4 and 5, paragraphs 0005-0012, 0032, 0040, 0058)*.

As per claims 21, Hausman teaches a method wherein if the match is successful, transmitting a notification to one or more broker dealers (*see figs 4, 5, paragraphs 0054)*.

(10) Response to Argument

102 Rejections

Claims 1, 7, 13, and 22-24

Appellant is of the opinion that the prior art of Hausman fails to anticipate Appellant's claimed method and apparatus as the prior art does not teach interpreting a message according to a coded meaning defined to be different than the standard, publicly known meaning within the field delimited communication protocol. The Examiner respectfully disagrees.

Initially, the Examiner would like to discuss what Appellant regards as his invention. Recall, Appellant asserts that the prior art is insufficient as it fails to teach Applicant's message interpreting. But according to Appellant, what performs this message interpretation? Appellant has identified paragraphs 0008, 0009, 0011, 0012, 0017, 0030-0035 and 0038 as portions of the Specification that teach Appellant's "interpreting" step. However, in each instant the interpretation is performed by a human being (e.g. "... to communicate coded instructions to *a message receiver* on *how to interpret* the contents of the financial message"-paragraph 0008; "... *buyer B would not interpret...*"-paragraph 003; "... *buyer C would not interpret...*"-paragraph 0032; "[seller] D would not interpret..."- paragraph 0033). Paragraph 0038 discloses the matching of messages by a secure repository. However, Appellant does not teach a

repository that performs the claimed step of interpreting a message according to a coded meaning defined to be different than the standard, publicly known meaning within the field delimited communication protocol. Hence, according to Appellant, the step of interpreting is performed by a human.

It has been held that patentability cannot be predicated on a "mental step" (In re Venner, 120 USPQ 192 (CCPA 1958)). Therefore, claim 1 is reduced to:

> receiving over an electronic computer network a message communicated according to a field delimited communication protocol pursuant to which the message comprises a financial data field and a field value corresponding to the financial data field and the message has a standard, publicly-known meaning within the field delimited communication protocol;

Which according to Appellant's own admission is taught by the prior art as Hausman teaches transmitting messages according to a FIX protocol (see Appellant's claim 2- "wherein the field delimited communication protocol is the Financial Information Exchange (FIX) protocol or a protocol derived therefrom"; Appeal Brief, page 13, lines 8-10- "Hausman does reference embodiments in which messages are optionally formatted according to a FIX protocol").

Nonetheless, Hausman does teach Appellant's interpretation step as the computer that receives the message according to the FIX protocol while the receiver of the message interprets the contents of the message according to a coded meaning different from the FIX protocol. For example, a user can enter a

ticker symbol, such as YEN or MSFT into field 311 of figure 3 ('632, paragraph 0034, lines 15-25; paragraph 0035, lines 1-4; paragraph 0065, lines 1-3). Therefore, when a (sell or buy) message is received by a buyer or seller, the buyer or seller is able to decode "YEN" or "MSFT" as a human would (e.g. Japanese currency or the ticker symbol of the company that makes Xbox360 or Vista, respectively) which is different than the FIX protocol coded message that the buyer or seller computer receives and interprets. More specifically, this distinction between human and computer processing is embodied in the definitions of information and data, specifically *information* is "the meaning of data as it is intended to be interpreted by people" while "computers process *data* without any understanding of what the data represents" (Microsoft Press Computer Dictionary Third Edition).

Claims 22-24

It has been held that a recitation with respect to the material intended to be worked upon by a claimed apparatus does not impose any structural limitations upon the claimed apparatus which differentiates it from a prior art apparatus satisfying the structural limitations of that claimed (*Ex parte Masham*, 2 USPQ2d 1647 (1987)). Hence, how a message is intended to interpreted by a human will not distinguish the claimed apparatus from the prior art ('632, figure 1, item 106).

Claims 3 and 9

Hausman discloses expressing a trade for stocks (paragraph 0034, lines 15-25; paragraph 0035, lines 1-4) in terms of quantity ('632, figure 3, item 308; paragraph 0062, lines 6-8), hence the prior art teaches messages that communicate the number of shares offered.

Claims 6,12 and 17

Hausman discloses an indication of interest such as a negotiable (as opposed to firm) bid or offer ('632, paragraphs 0036).

Claims 4 and 10

Hausman discloses messages according to a FIX protocol ('632, paragraph 0041). Hence, Hausman necessarily anticipates any message that can be described using the protocol such as a FIX tag 38 message.

Claim 15

Hausman discloses order fields ('632, figure 3).

Claims 18-20

Appellant is of the opinion that the prior art does not teach whether field values in messages match. The Examiner respectfully disagrees as Hausman

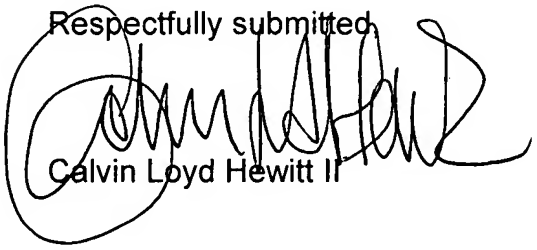
teaches whether values in fields match such as index and index limit values match within a message ('632, paragraphs 0038 and 0039) and between messages ('632, paragraph 0042, lines 16-20).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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